

REMARKS

Allowable Subject Matter

Claim 11 has been objected to by the examiner for lack of antecedent basis for the limitation "the fastener" and as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 11 has been amended to overcome the objection based on insufficient antecedent basis and has been rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Reconsideration of claim 11 is respectfully requested in light of the amendments and the arguments presented herein.

Based on the foregoing, applicant requests that claim 11, as amended, be allowed.

35 U.S.C. §102 Rejections

Claims 1-6, 10, and 12-17 have been rejected under 35 U.S.C. 102(e) as being anticipated by Benavides, U.S. Patent No. 6,687,931.

Applicant submits her Affidavit under Rule 131 to establish invention of the subject matter of the rejected claims prior to the effective date of the Benavides patent. It is clear from the Applicant's Affidavit shows that the inventor reduced the invention to practice by creating a prototype before the filing date of the Benavides patent.

Based on the foregoing, applicant respectfully requests that the foregoing rejection be withdrawn and that said claims 1-6, 10, and 12-17, be allowed.

Moreover, claim 1 has been amended to further distinguish her invention from Benavides. Claim 1 now requires that the proximal end of the first pocket be independent of attachment of the second pocket. This limitation is clearly evident in all of the figures of the drawing, particularly in Figures 1 and 2. An advantage of having the opening of one of the pockets free of attachment from the other. Benavides requires that panels 12, 16 and 18 are stitched together along edge 28 and that panels 14, 16 and 18 are stitched together along edge 30 (Col. 3, lines 52-55) and claim 1 of Benavides. The instant invention is independent of such limitation.

Claims 2 and 3 are preferred embodiments of amended claim 1 and are entitled to patentability on the same basis of amended claim 1.

Claim 4 has been amended to incorporate the amendment made to amended claim 1, This distinguishing aspect is entitled to patentability on the same basis as amended claim 1. The arguments presented as to amended claim 1 are applicable to amended claim 4 as well.

Claims 5 and 6 are dependent upon amended claim 4 and entitled to patentability on the same basis as amended claim 4.

Claims 10 and 12 are preferred embodiment of amended claim 1 and are entitled to patentability on the same basis of amended claim 1.

Claims 13 and 14 are preferred embodiments of claim 12 which is now based on amended 1, and said claims are entitled to patentability on the same basis of amended claim 1.

Claim 15 has been amended to include and incorporate the limitation in amended claim 1.

Claims 16 and 17 are dependent on amended claim 15 and entitled to patentability on the same basis as amended claim 15.

Additionally, claims 7-8 and 18 have been rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,419,779 to Janesh.

A section 102 (b) rejection requires, *inter alia*, that the invention was patented or described and that the patent was patented in this country more than one year prior to the date of the application or the patent in the United States.

It is well settled that in order to anticipate a claim for a patent and render it invalid, a single prior art reference must contain each and every element of the claimed invention. *Hybritech Inc. v. Monoclonal Antibodies, Inc.* 802 F.2d 1367 (Fed. Cir. 1986).

Janesh fails to disclose each and every element of the claimed invention. Claim 7 requires a “case for enclosing a pillow”... “whereby, a pillow...can be inserted and covered by [the case]...to enclose the pillow.” The pillow construction and method of Janesh fails to enclose a pillow. It does not enclose the pillow insert 26 as stated and can only enclose a pillow by using two distinct and unattached members, the pillow construction 23 and the pillow insert 26. The instant invention has only a single sheet member.

Additionally, the examiner suggests that the first end of the sheet of Janesh is 30, which is shown only in Figure 6. If the first end is 30, then according to claim 7, the single sheet should be three pillow insert lengths in length from end 30 to an opposite end and two pillow insert widths wide for the first pillow length at the first end. Neither Figure 6 nor the disclosure of the Janesh patent satisfies these specific requirements. Additionally, claim 7 requires that when the first end is folded lengthwise forming a double layer, that a first pocket is formed with an opening proximate the first end. This configuration is readily apparent in Figures 10, 11 and 12

of the drawing, but is not taught or disclosed in Janesh. Moreover, original claim 7 requires that when the second pillow end is folded widthwise and a portion peripherally attached, forming a second pocket with an opening proximate to the first pocket is formed. This element is not taught nor suggested by Janesh.

5 Lastly, the case for enclosing a pillow of the instant invention, allows for a pillow to be inserted into one of the first pocket and a second pocket and that such pillow stuffed pocket can be inserted into and covered by the other of the first pocket and second pocket to enclose the pillow. This again, Janesh is incapable of doing. Janesh cannot have its first pocket or second pocket, as those terms are being used, inserted into the other of the first and second pocket of the
10 pillow. Janesh is only capable of enclosing a pillow if after closing of a first sheet and second sheet pillow insert 26 is inserted into the pocket to seal the opening. This manner of enclosure is distinctly different of that claimed by original claim 7.

Claim 8 is a preferred embodiment of amended claim 7 and entitled to patentability on the same basis of original claim 7.

15 Reconsideration of Claims 7-8 under 35 U.S.C.102(b) as being unpatentable in view of Janesh is requested in light of the arguments presented herein.

Based on the foregoing, applicant requests that Claims 7-8, as amended, be allowed.

The same arguments as presented for claim 7 and applicable to claim 18 as well. Claim 18 deals with a method of encasing a pillow, to enclose the pillow, with a single folded sheet,
20 unlike the Janesh pillow which required at least two separate sheet elements in order to effectuate an enclosure.

Reconsideration of claim 18 under 35 U.S.C.102(b) as being unpatentable in view of Janesh is requested in light of the arguments presented herein.

Based on the foregoing, applicant requests that Claim 18, be allowed.

35 U.S.C. §103 Rejections

5 Claim 9 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Benavides in view of U.S. Patent No. 6,196,156 to Denesuk.

The primary reference, Benavides, is inappropriate for the reasons set forth in the earlier remarks in connection with the 102 rejections and those deficiencies are not corrected by combining it with Denesuk.

10 Claim 9 is preferred embodiment of amended claim 1 and is entitled to patentability on the same basis as amended claim 1.

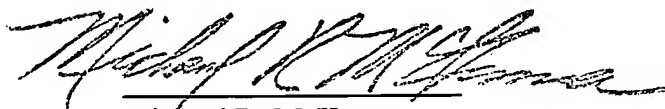
Reconsideration of Claim 9 under 35 U.S.C.103(a) as being unpatentable over Benavides in view of U.S. Patent No. 6,196,156 to Denesuk is requested in light of the amendments and the arguments presented herein.

15 Based on the foregoing, applicant requests that Claim 9, as amended, be allowed.

CONCLUSION

For all the above reasons, applicant believes that all the claims presented in this application are allowable over the prior art, and any early allowance of the application is earnestly solicited. Formal drawings will be submitted upon notice of allowance.

Respectfully submitted,



Michael R. McKenna
Registered Patent Attorney
Reg. No. 32,368

MICHAEL R. MCKENNA
500 West Madison Street
Suite 3800
Chicago, Illinois 60661
(312) 321-0123

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Commissioner of Patents and Trademarks, PO Box 1450, Alexandria, VA 22313-1450 on 1/20/05.

Date: 1/20/05 Signed: Ruth Zar Leib